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MORRIS MANNING & MARTIN LLP 1600 ATLANTA FINANCIAL CENTER 3343 PEACHTREE ROAD, NE ATLANTA, GA 30326-1044			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/552,073

Applicant(s)

COYLE ET AL.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-84 and 118-129 is/are pending in the application.
- 4a) Of the above claim(s) 85-117 and 130-157 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-84 and 118-129 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 26-157 are pending. The Applicants' election without further traverse of Group I, claims 26-84 and 118-129 in the reply filed on 04/05/05 is acknowledged. Claims 85-117 and 130-157 have been withdrawn/cancelled and claims 26-84 and 130-157 will be examined on the merits.

Answer to Arguments With Traverse

2. The traversal was on the ground(s) that this election is without admission of the propriety of the grouping of the claims, or of the examiner's reasoning as to the distinctions between the groups, and without prejudice to the pursuit of the non-elected subject matter through one or more divisional applications. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 26, 27, and 61, are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,650,604) Marcous, et al.

As per claim 26, Marcous teaches, In a payment system of a licensed money transmitter operative to maintain data records indicative of an amount of funds associated with an individual, the licensed money transmitter maintaining a network of agent terminals at various locations for disbursing funds to authorized recipients, an

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improvement for issuing a negotiable instrument corresponding to a predetermined direct deposit of funds on behalf of the individual, comprising:

an account maintained at a regulated financial institution and associated with the licensed money transmitter for receiving direct deposits of funds on behalf of individuals not maintaining accounts at the financial institution (col. 1, line 66-col. 2, line 14 and col. 3, lines 4-18); a transaction account maintained by the licensed money transmitter, the transaction account being unauthorized to accept direct deposits of funds because of regulatory restrictions in the transaction account being disburseable by said agent terminals (col. 3, line 59-col. 4, line 15); the financial institution responsive to a deposit of a predetermined amount of funds by direct deposit for the benefit of the individual for sweeping the funds represented by the direct deposit into the transaction account and communicating an electronic notification to the licensed money transmitter of the direct deposit (col. 5, lines 50-65); the licensed money transmitter being responsive to (a) a request for issuance of a negotiable instrument of a predetermined amount (col. 6, line 21 –col. 7, line 5 and lines 41-65) and (b) the electronic notification of the direct deposit of funds swept into the transaction account for issuing a prepaid negotiable instrument in an amount equal to or less than with the amount of the direct deposit the negotiable instrument being identifying information associated with the individual for use in making financial transactions, from the transaction account based on the direct deposit of funds to the financial institution, whereby an individual bearing the prepaid negotiable instrument may obtain funds and/or instruct that payments be made of the directly deposited funds by presentation of the negotiable instrument to an

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agent of the licensed money transmitter (col. 8, lines 53-67 and col. 9, line 7-col. 10, line 22). Marcous did not expressly disclose the deposit was made prior to the recipient being able to access the funds. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the deposit made prior to the recipient being able to access the funds and to modify in Marcous because such a modification would allow Marcous to have the capability to make a deposit prior to a recipient being able to access any funds in his system. It is well known that a deposit of funds has to be made prior to the funds being accessed by anyone.

As per claim 27, Marcous teaches, the improvement of claim 26, wherein the negotiable instrument is selected from the group comprising a magnetic stripe card, a cash card, a check, a draft, a warrant, a money order, a transit check (col. 2, lines 39-43 and col. 3, lines 50-56 and lines 62-63).

5. Claims 28-47, 62-81, 123, and 127-129 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,650,604) Marcous et al, here after Marcous in view of (US 5,457,305) Akel et al, hereafter Akel.

As per claims 28, 62, and 123, Marcous teaches, The improvement of claim 26, wherein the request for issuance of the negotiable instrument of a predetermined amount originates at a POS terminal operated by an agent of the licensed money transmitter (col. 2, lines 5-10). Marcous failed to teach a POS terminal. Akel teaches, a POS terminal (col. 4, lines 40-45). It would have been obvious to one having ordinary

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skill in the art at the time the invention was made to have a POS terminal and to modify in Marcous because such a modification would allow Marcous to have a computer used in place of a cash register that is capable of recording transactions, printing receipts, and handling credit and debit card payments.

As per claims 29 and 63, Marcous teaches, The improvement of claim 26, wherein the request for issuance of the negotiable instrument originates from an automated teller machine (ATM) (col. 2, lines 44-47 and col. 3, lines 59-67).

As per claims 30 and 64, Marcous teaches, The improvement of claim 26, wherein the transaction account is replenished by a deposit from a source other than direct deposit at the regulated financial institution (col. 2, line 52-col. 3, line 18).

As per claims 31 and 65, Marcous teaches, The improvement of claim 30, wherein the transaction account is replenished by a cash deposit via an automated teller machine (ATM), a POS terminal associated with the licensed money transmitter, or a non-direct deposit at a financial institution (col. 4, lines 6-30). Marcous failed to teach a POS terminal. Akel teaches a POS terminal (col. 4, lines 40-45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a POS terminal and to modify in Marcous because such a modification would allow Marcous to have a computer used in place of a cash register that is capable of recording transactions, printing receipts, and handling credit and debit card payments.

As per claims 32 and 66, Marcous teaches, The improvement of claim 26, wherein the individual is provided with a cash card for use in transactions associated with the transaction account (col. 3, lines 59-63).

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As per claims 33 and 67, Marcous teaches, The improvement of claim 33, wherein the cash card includes identifying information (col. 4, lines 16-30).

As per claims 34 and 68, Marcous failed to teach, The Improvement of claim 33, wherein the cash card includes human readable identifying information on one side and a magnetic stripe on another side, the magnetic stripe being readable by a POS terminal operated by an agent of the licensed money transmitter for obtaining the account identifier from the magnetic stripe. Akel teaches, wherein the cash card includes human readable identifying information on one side and a magnetic stripe on another side, the magnetic stripe being readable by a POS terminal operated by an agent of the licensed money transmitter for obtaining the account identifier from the magnetic stripe (col. 4, lines 27-32). These claims are rejected for the similar rationale as given above for claims 31, 32, 65, and 66.

As per claims 35 and 69, Marcous teaches, The improvement of claim 33, wherein the identifying information of the cash card includes an account identifier and a customer name (col. 4, line 65-col. 5, line 9 and lines 58-67).

As per claims 36 and 70, Marcous teaches, The improvement of claim 32, wherein the cash card is an anonymous cash card and the identifying information of the cash card only includes an account identifier (col. 4, lines 6-41).

As per claims 37 and 71, Marcous teaches, The improvement of claim 32, wherein a personal identifying number (PIN) is associated with the cash card, and the licensed money transmitter only conducts transactions with respect to the transaction

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account upon presentation of the card and a corresponding PIN (col. 4, line 65-col. 5, line 10 and lines 29-43).

As per claims 38 and 72, Marcous failed to teach, The improvement of claim 32, wherein presentation of the cash card by an individual to a POS terminal of the licensed money transmitter is treated by the licensed money transmitter as the request for issuance of another negotiable instrument. Akel teaches, wherein presentation of the cash card by an individual to a POS terminal of the licensed money transmitter is treated by the licensed money transmitter as the request for issuance of another negotiable instrument (col. 6, lines 21-55). These claims are rejected for the similar rationale as given above for claims 28, 31, 34, 62, 65, and 68.

As per claims 39 and 73, Marcous teaches, The improvement of claim 32, wherein the cash card is a negotiable instrument (col. 6, lines 56-67).

As per claims 40 and 74, Marcous failed to teach, The improvement of claim 32, wherein presentation of the cash card by an individual to a POS terminal of the licensed money transmitter is accessed by the licensed money transmitter as the request for disbursement of cash by an agent of the licensed money transmitter. Akel teaches, wherein presentation of the cash card by an individual to a POS terminal of the licensed money transmitter is accessed by the licensed money transmitter as the request for disbursement of cash by an agent of the licensed money transmitter (col. 8, lines 19-28). These claims are rejected for the similar rationale as given above for claims 28, 31, 34, 62, 65, and 68.

As per claims 41 and 75, Marcous teaches, The improvement of claim 32, wherein presentation of the cash card by an individual to ATM is treated by the licensed money transmitter as the request for disbursement of cash by the ATM (col. 8, lines 11-22):

As per claims 42 and 76, Marcous teaches, The improvement of claim 32, wherein presentation of the cash card by an individual to a POS terminal of the licensed money transmitter to an ATM together with the presentation of cash is treated by the licensed money transmitter as the request for deposit of the cash to the transaction account associated with the individual (col. 8, lines 23-42). Marcous failed to teach a POS terminal as discussed above in claims 28, 31, 34, 62, 65, and 68.

As per claims 43 and 77, Marcous teaches, The improvement of claim 32, wherein the cash card is issued to an individual by the licensed money transmitter or an agent thereof after enrollment of the individual as a customer of the licensed money transmitter and provision of customer information (col. 1, lines 14-37 and col. 6, lines 21-55).

As per claims 44 and 78, Marcous teaches, The improvement of claim 43, wherein the privilege of depositing additional funds to the transaction account is only provided to enrolled customers of the licensed money transmitter (col. 2, lines 5-14).

As per claims 45 and 79, Marcous teaches, The improvement of claim 32, wherein the cash card is an anonymous cash card only bearing an account number and a personal identifying number (PIN), and wherein anonymous transactions involving the transaction account may be effected upon presentation by the individual of the cash

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card to an agent of the licensed money transmitter and the PIN (col. 5, lines 16-67 and col. 6, lines 1-10).

As per claims 46 and 80, Marcous teaches, The improvement of claim 45, wherein the anonymous cash card is a one-load cash card and is invalidated upon depletion of the predetermined funds in the transaction account (col. 7, lines 59-65 and col. 8, lines 11-22).

As per claims 47 and 81, Marcous teaches, The improvement of claim 45, wherein the anonymous cash card is converted into a regular cash card and enabled for use in connection with subsequent deposits of funds to the transaction account and further transactions upon enrollment of the individual as a customer of the licensed money transmitter (col. 8, line 53-col. 9, line 29 and lines 40-57).

As per claims 82 and 127, Marcous failed to teach, The system of claim 58, wherein the transaction control module is further operative for: receiving a balance increase request message from a POS terminal, the balance increase request message indicating that the balance of the transaction account for the benefit of the particular individual is to be increased by a requested amount and that the individual has rendered a payment in the requested amount to the agent of the licensed money transmitter. Akel teaches, receiving a balance increase request message from a POS terminal, the balance increase request message indicating that the balance of the transaction account for the benefit of the particular individual is to be increased by a requested amount and that the individual has rendered a payment in the requested amount to the agent of the licensed money transmitter (col. 7, lines 14-22 and col. 8, lines 19-28). It

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would have been obvious to one having ordinary skill in the art at the time the invention was made to receive a balance increase request message from a POS terminal, the balance increase request message indicating that the balance of the transaction account for the benefit of the particular individual is to be increased by a requested amount and that the individual has rendered a payment in the requested amount to the agent of the licensed money transmitter and to modify in Marcous because such a modification would allow Marcous to process a transaction request and coordinate the authorization and printing of the receipt at the POS terminal. Marcous teaches, in response to the balance increase request, communicating a message to credit the requested amount to the balance of the transaction account for the benefit of the individual (col. 6, line 56-col. 7, line 5).

As per claims 83 and 128, Marcous teaches, The system of claim 58, wherein the operation of the transaction control module for determining that the balance in the transaction account associated with the particular individual equals or exceeds the requested predetermined amount for the negotiable instrument comprises: receiving a PIN and an account number from the POS terminal purporting to identify a transaction account associated with the particular individual (col. 6, lines 21-55); determining that the account number identifies a transaction account (col. 7, lines 25-65); determining that the PIN identifies the individual as being authorized to access the transaction account (col. 8, lines 53-67 and col. 9, lines 1-11 and 25-30); and comparing the predetermined amount of the requested negotiable instrument plus any applicable fees

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to the balance of the transaction account (col. 9, line 58-col. 10, line 22). This dependent claim is rejected for the similar rationale as given above for claim 82.

As per claims 84 and 129, Marcous teaches, The system of claim 58, wherein the transaction control module is further operative for authorizing the issuance of a plurality of negotiable instruments so long as the balance in the transaction account contains adequate funds therefor (col. 6, line 54- col. 7, line 5 and lines 41-65).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 48-58, 118, 122, and 126 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,650,604) Marcous et al, hereafter Marcous in view of (US 6,012,048) Gustin et al, hereafter Gustin.

As per claim 48, Marcous teaches, A method for a licensed money transmitter to issue a prepaid negotiable instrument to an individual based on a direct deposit of funds in a regulated financial institution, composing the steps of arranging for communication of notifications between a regulated financial institution and the licensed money transmitter corresponding to a direct funds deposit, the direct funds deposit corresponding to a direct deposit of funds to the account of the licensed money transmitter for the benefit of a particular individual (col. 1, line 66-col. 2, line 14); at the regulated financial institution, detecting a direct deposit of funds into an account for the

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benefit of the particular individual; communicating a notification of the direct deposit of funds to the licensed money transmitter (col. 2, lines 34-38); at the regulated financial institution, automatically sweeping the total amount of the direct deposit of funds into a transaction account associated with the licensed money transmitter, the total amount of the direct deposit of funds being added to a current balance of the transaction account; receiving from an agent of the licensed money transmitter a communication comprising a request by the individual for the issuance of a requested prepaid negotiable instrument having a predetermined value (col. 9, lines 12-33). Marcous failed to teach, at the licensed money transmitter, and in response to the request for issuance of the prepaid negotiable instrument, determining that the value of the requested prepaid negotiable instrument is not in excess of the balance of the transaction account; at the licensed money transmitter, and in response to a determination that the value of the requested prepaid negotiable instrument is not in excess of the balance of the transaction account, communicating an authorization for issue of the requested prepaid negotiable instrument to the agent; and at the licensed money transmitter, and in response to the issuance of the requested prepaid negotiable instrument, automatically debiting the balance of the transaction account by the value of the requested negotiable instrument. Gustin teaches, at the licensed money transmitter, and in response to the request for issuance of the prepaid negotiable instrument, determining that the value of the requested prepaid negotiable instrument is not in excess of the balance of the transaction account (col. 18, line 55 – col. 19, line 10); at the licensed money transmitter, and in response to a determination that the value of the requested prepaid

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negotiable instrument is not in excess of the balance of the transaction account, communicating an authorization for issue of the requested prepaid negotiable instrument to the agent (col. 4, lines 18-44 and col. 19, lines 11-44); and at the licensed money transmitter, and in response to the issuance of the requested prepaid negotiable instrument, automatically debiting the balance of the transaction account by the value of the requested negotiable instrument (col. 19, lines 35-39).

Claim 49. Marcous and Gustin failed to teach, The method of claim 48, wherein the account at the financial institution is a first account and the transaction account is a second account, and wherein the step of automatically sweeping the total amount of the direct deposit of funds into the transaction account comprises posting a debit in the total amount of the funds in the first account and posting a credit in the total amount of the funds in the second account, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the account at the financial institution as a first account and the transaction account as a second account, and wherein the step of automatically sweeping the total amount of the direct deposit of funds into the transaction account comprises posting a debit in the total amount of the funds in the first account and posting a credit in the total amount of the funds in the second account and to modify in Marcous because such a modification would allow Marcous to have simply an accounting method for performing the transactions and transferring the funds as a direct deposit. Debiting a first account and crediting a second account are well known in the art of accounting, record keeping, and bookkeeping.

Claim 50. Marcous failed to teach, The method of claim 48, wherein the regulated financial institution is subject to federal banking regulations and wherein the licensed money transmitter is not subject to federal banking regulations. Gustin teaches, wherein the regulated financial institution is subject to federal banking regulations and wherein the licensed money transmitter is not subject to federal banking regulations (col. 2, lines 22-38 and col. 8; lines 9-16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the regulated financial institution subject to federal banking regulations and wherein the licensed money transmitter not subject to federal banking regulations and to modify in Marcous because such a modification would allow Marcous to have the capability to wire transfer money through other companies such as Western Union which are not regulated by federal banking regulations and while banks are subject to federal banking regulations imposed by the Federal Government.

Claims 51 and 126. Marcous failed to teach, The method of claim 50, wherein the regulated financial institution is a bank. Gustin teaches, the regulated financial institution is a bank (col. 8, lines 9-16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the regulated financial institution to be a bank and to modify in Marcous because such a modification would allow Marcous to have an automated banking system that has components for receiving an ATM card when inserted through an insert, slot or opening since the slot will accept the usual ATM card, credit cards, IC cards or smart cards.

Claim 52. Marcous failed to teach, The method of claim 48 wherein the step of determining that the value of the requested negotiable instrument is not in excess of the balance of the transaction account comprises determining that the value of the requested negotiable instrument plus any fees charged to the individual is not in excess of the balance of the transaction account. Gustin teaches, determining that the value of the requested negotiable instrument is not in excess of the balance of the transaction account comprises determining that the value of the requested negotiable instrument plus any fees charged to the individual is not in excess of the balance of the transaction account (col. 17, lines 12-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine that the value of the requested negotiable instrument is not in excess of the balance of the transaction account comprises determining that the value of the requested negotiable instrument plus any fees charged to the individual is not in excess of the balance of the transaction account and to modify in Marcous because such a modification would allow Marcous to have the ability to see the transaction amount plus any fees and to see the account balance to prevent going over the account balance.

Claim 53. Marcous failed to teach, The method of claim 48, wherein the individual requests the issuance of multiple negotiable instruments; wherein determining that the value of the requested negotiable instrument is not in excess of the balance of the transaction account comprises determining that the aggregate value of the requested multiple negotiable instruments is not is excess of the balance of the transaction account; wherein communicating the authorization of the issuance of the

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requested negotiable instrument to the individual comprises communicating authorization of the issuance of the requested multiple negotiable instruments to the individual; and wherein debiting the balance of the transaction account by the value of the requested negotiable instrument comprises debiting the balance of the transaction account by the aggregate value of the requested multiple negotiable instruments. Gustin teaches, wherein the individual requests the issuance of multiple negotiable instruments (col. 9, lines 46-59); wherein determining that the value of the requested negotiable instrument is not in excess of the balance of the transaction account comprises determining that the aggregate value of the requested multiple negotiable instruments is not in excess of the balance of the transaction account (col. 19, line 4-col. 20, line 67) and wherein communicating the authorization of the issuance of the requested negotiable instrument to the individual comprises communicating authorization of the issuance of the requested multiple negotiable instruments to the individual (col. 21, line 4-col. 22, line 25). Marcous and Gustin failed to teach, wherein debiting the balance of the transaction account by the value of the requested negotiable instrument comprises debiting the balance of the transaction account by the aggregate value of the requested multiple negotiable instruments, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in Marcous because such a modification would allow Marcous to have what is well known in the art of accounting the ability to perform a simple accounting function.

Claim 54. Marcous failed to teach, The method of claim 53, wherein determining that the aggregate value of the requested multiple negotiable instruments is not is

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excess of the balance of the transaction account comprises determining that the aggregate value of the requested multiple negotiable instruments plus any fees charged to the individual is not in excess of the balance of the transaction account. Gustin teaches, determining that the aggregate value of the requested multiple negotiable instruments is not is excess of the balance of the transaction account comprises determining that the aggregate value of the requested multiple negotiable instruments plus any fees charged to the individual is not in excess of the balance of the transaction account (col. 1, lines 28-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine that the aggregate value of the requested multiple negotiable instruments is not is excess of the balance of the transaction account comprises determining that the aggregate value of the requested multiple negotiable instruments plus any fees charged to the individual is not in excess of the balance of the transaction account and to modify in Marcous because such a modification would allow Marcous to know the total amount of the negotiable instruments plus the transaction fee for each negotiable instrument and to know how much is in the transaction account in order to not be charged an extra fee for being over the balance in the transaction account.

Claim 55. Marcous teaches, The method of claim 48, further comprising: detecting a balance increase request by the individual, the balance increase request indicating that the balance of the transaction account is to be increased by a requested amount and that the individual has tendered a payment in the requested amount; in

response to the balance increase request, crediting the requested amount to the second account (col. 6, line 56-col. 7, line 5 and col. 7, lines 6-23).

Claim 56. Marcous teaches, The method of claim 48, wherein the step of determining that the value of the requested prepaid negotiable instrument is not in excess of the balance of the transaction account comprises: at the agent of the licensed money transmitter, receiving a PIN and an account number provided by the requesting individual (col. 9, line 58-col. 10, line 6); communicating the individual-provided account number and PIN to the licensed money transmitter (col. 7, lines 42-65); at the licensed money transmitter, determining that the individual-provided account number identifies the transaction account (col. 8, lines 53-67); at the licensed money transmitter, determining that the PIN identifies the individual as being authorized to access the transaction account (col. 9, lines 1-29); and at the licensed money transmitter, comparing the value of the requested prepaid negotiable instrument to the balance of the transaction account (col. 9, lines 40-58). Marcous did not expressly disclose comparing a value of the requested prepaid negotiable instruments to a balance of the transaction account. However, Marcous does teach, an ATM that can cash payroll checks, pay bills, use an ATM card or debit card to get cash or to transfer funds. It would have been obvious to one having ordinary skill in the art at the time the invention was made to compare a value of the requested prepaid negotiable instruments to a balance of the transaction account and to modify in Marcous because such a modification would allow Marcous to have an accurate accounting record for the prepaid negotiable instruments.

Claim 57. Marcous teaches, The method of claim 48, further comparing the step of at the agent of the licensed money transmitter, and in response to receipt by the agent of the authorization for issuance of the requested prepaid negotiable instrument, issuing a prepaid negotiable instrument in the amount of the request, less any applicable transaction fees (col. 9, line 58 –col. 10, line 36).

Claims 58 and 122, Marcous teaches, A computer-controlled negotiable instrument payment system for negotiable instrument transactions conducted by a particular individual based on the direct deposit of funds at a regulated financial institution at which the particular individual does not maintain an account, comprising: a licensed money transmitter that maintains a network of agent terminals (col. 3, line 59-col. 4, line 5 and lines 48-64); an account maintained at the financial institution on behalf of the licensed money transmitter for receipt of direct deposits for the benefit of individuals not maintaining an account at the financial institution (col. 3, line 59-col. 4, line 15); a computer system operated by the licensed money transmitter (col. 4, line 42-64); a data communications interface associated with the computer system for data communications with a transaction system of the financial institution (col. 4, lines 48-60); an account sweep control module run by the computer system responsive to a notification received via the data communications interface from the financial institution indicating the direct deposit of funds in a predetermined deposit amount into the account at the financial institution for communicating a debit posting message indicating the predetermined deposit amount to the financial institution transaction system, the account sweep control module being further operative for crediting the predetermined

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deposit amount to a transaction account maintained by the licensed money transmitter for the benefit of the individual associated with the deposit (col. 5, lines 50-67 and col. 6, lines 1-10 and line 51 –col. 7, line 5); a transaction control module run by the computer system and operative, in response to a request from a requesting source for issuance of a negotiable instrument in a predetermined amount for a particular individual for: determining whether the balance in the transaction account associated with the particular individual equals or exceeds the requested predetermined amount (col. 5, lines 33-63); and in response to a determination that the balance in the transaction account associated with the particular individual equals or exceeds the requested predetermined amount, communicating an authorization for issuance of the negotiable instrument in the requested predetermined amount to an agent terminal (col. 9, line 58-col. 10, line 6). Marcous failed to teach, in response to the receipt from the agent terminal of a notification indicating the issuance of the negotiable instrument in the requested predetermined amount, posting a debit of the requested predetermined amount. Gustin teaches, in response to the receipt from the agent terminal of a notification indicating the issuance of the negotiable instrument in the requested predetermined amount, posting a debit of the requested predetermined amount (col. 18, line 55-col. 19, line 44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have in response to the receipt from the agent terminal of a notification indicating the issuance of the negotiable instrument in the requested predetermined amount, posting a debit of the requested predetermined amount. Gustin teaches, in response to the receipt from the agent terminal of a

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notification indicating the issuance of the negotiable instrument in the requested predetermined amount, posting a debit of the requested predetermined amount and to modify in Marcous because such a modification would allow Marcous to have a wire transfer that would have a number to be entered as the federal routing number and a deposit to be made with a printout receipt showing payment and a wire transfer.

As per claim 118, Marcous teaches, A method for a licensed money transmitter to issue a prepaid negotiable instrument to an individual based on the direct deposit of funds at a regulated financial institution, comprising the steps of: at an agent of the licensed money transmitter, providing the individual with an account number and a PIN for subsequent use in obtaining the issuance of a prepaid negotiable instrument (col. 4, line 65-col. 5, line 10 and lines 29-43); at the financial institution, receiving a direct deposit of funds from the benefit of the individual for use in connection with funding the issuance of prepaid negotiable instruments (col. 2, lines 2-14); communicating a notification message from the financial institution to the licensed money transmitter indicating the direct deposit of funds to an account associated with the licensed money transmitter for the benefit of the individual (col. 2, line 52-col. 3, line 3); and in response to the direct deposit of funds at the financial institution, sweeping funds in an amount corresponding to the direct deposit of funds from the account at the financial institution to the credit of a transaction account with the licensed money transmitter (col. 5, lines 50-65). This independent claim is rejected for the similar rationale as given above for claims 52 and 53.

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8. Claims 59, 60, 119-121, 124, and 125 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,650,604) Marcous et al, hereafter Marcous and (US 6,012,048) Gustin et al, hereafter Gustin and further in view of (US 5,875,437) Atkins et al, hereafter Atkins.

Claim 59, Marcous and Gustin failed to teach, The system of claim 58, wherein the requesting source comprises an automated teller machine (ATM), an agent point of sale (POS) terminal, or a card reader terminal. Atkins teaches, the requesting source comprises an automated teller machine (ATM), an agent point of sale (POS) terminal, or a card reader terminal (col. 34, lines 19-27). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the requesting source comprise an automated teller machine (ATM), an agent point of sale (POS) terminal, or a card reader terminal and to modify in Marcous because such a modification would allow Marcous to have a computerized terminal providing cash dispensing and deposit acceptance banking transactions 24-hours a day and a POS system that is a computer used in place of a cash register for recording transactions.

As per Claims 60 and 125. Marcous teaches, The system of claim 58, wherein the regulated financial institution is subject to federal banking regulations and wherein the licensed money transmitter is not subject to federal banking regulations (col. 1, line 66-col. 2, line 14, and col. 3, lines 4-18).

As per claim 119. Marcous teaches, The method of claim 118, further comprising the steps of subsequent to the issuance of the prepaid negotiable instrument

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in the requested amount, communicating a message from the agent to the licensed money transmitter indicating the issuance of the prepaid negotiable instrument; at the licensed money transmitter, posting a debit in the amount of the prepaid negotiable instrument, less any applicable transaction fees, to the transaction account associated with the account number and the PIN (col. 9, lines 40-57) .

Claim 120. Marcous teaches, The method of claim 118, further comprising the step of cashing the issued negotiable investment at the agent and providing the individual with cash (col. 9, line 58-col. 10, line 6).

Claim 121. Marcous failed to teach, The method of claim 118, further comprising the steps of at the agent of the licensed money transmitter, receiving a request from the individual to increase the balance of the transaction account in a requested amount, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have at the agent licensed money transmitter, receiving a request from the individual to increase the balance of the transaction account in a requested amount and to modify in Marcous because such a modification would allow Marcous to transfer more funds to the individual if Marcous agreed to increase the balance of the transaction account. Marcous teaches, determining that the individual is authorized to increase the balance of the transaction account (col. 5, lines 50-67); receiving from the individual a payment in a particular amount; generating a balance increase request requesting that the transaction account be edited is the requested amount; and communicating the balance increase request from the agent to the licensed money transmitter (col. 9, line 67-col. 10, line 6).

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Claim 124. Marcous teaches, The system of claim 122, further comprising a support personnel system operatively associated with the computer system of the licensed money transmitter for providing computer support services far support personnel of the licensed money transmitter, in connection with transactions conducted with the system (col. 4, lines 42-64).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gatto (US 5,546,523) disclosed an electronic fund transfer (EFT) system for custom transactions.

Inquiries

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday-Thursday, 6:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert
July 19, 2005